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In re Application of
Wakita, et al.
Application No. 09/763,014
Filing Date: 29 May, 2001
Attorney Docket No. IOMC-0039

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OFFICE OF PETITIONS

This is a decision on the petition filed on 12 May, 2004, as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record reflects that:

- it appeared Petitioner failed to reply timely and properly to the final Office action mailed on 16 May, 2003, with reply due absent extension of time on or before Monday, 18 August, 2003;
- Petitioner attempted to file an after-final amendment in the form of an Amendment by a Substitute Specification on 16 September, 2003, however, it was deemed by the Examiner in an Advisory action mailed on 10 October, 2003, not to be a proper reply to the final Office action;¹

¹ The proper response to the final Office action (see: MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a Continuing Application or Request for Continued Examination (RCE) (with fee and submission) under 37 C.F.R. §1.114.

- on 13 November, 2003, Petitioner filed a Notice of Appeal and fee (via US Postal Service Express Mail EL997978065US), with an authorization for required fees including a three-(3-) month extension of time—hand Office records clearly show the fees authorized and charged at that time;
- on 10 March, 2004; the Office mailed a Notice of Abandonment;
- Petitioner filed the instant petition with showings including the timely receipt by the Office of the Notice of Appeal;
- Petitioner has supplemented the record with a documents—including a USPS Express Mail tracking report to evidence timely receipt by the Office of the Appeal Brief (in triplicate) with fee and required extension of time.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁸

Petitioner evidences timely and proper reply (Notice of Appeal) to the Office action in question.

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, the 10 March, 2004, Notice of Abandonment is **vacated**, and the petition fee is waived.

The file is forwarded to Technology Center 2600 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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Office of Petitions

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).